

reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved)."

Additionally the Applicant highlights *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993) which is discussed at MPEP 2141.01.(a).V. In *Wang Laboratories, Inc. v. Toshiba Corp.*, the Patent claims were directed to single in-line memory modules (SIMMs) for installation on a printed circuit motherboard for use in personal computers. Reference to a SIMM for an industrial controller was not necessarily in the same field of endeavor as the claimed subject matter merely because it related to memories. Reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories.

The decision in *Wang Laboratories, Inc. v. Toshiba Corp* is analogous to the current matter. Although Duffield et al discloses an ink jet printer, Duffield et al is in a different field of endeavor because it does not relate to a printhead assembly for a camera system.

Therefore, the Applicant respectfully submits that Duffield et al is not a reference relevant for considerations under 35 USC § 103.

The Examiner has relied upon Duffield et al for disclosing a number of the integers of claim 1. However, the Applicant respectfully disagrees that all features have been taught or suggested by the combination of references.

In particular, the Examiner states on page 3 of the Office Action that Duffield et al teaches "*at least one printhead integrated circuit (4) that is positioned in the outlet to span the printing path*". The Applicant respectfully disagrees that Duffield et al teaches that the printhead is an integrated circuit and also notes that there is no teaching that the printhead spans the printing path. At column 5, lines 38 and 39 Duffield et al states that "*when the printing head is moving*", thereby teaching that the printhead should be smaller than the span of the printing path as it is required to move relative to the page being printed.

The teachings of Suzuki *et al* with Duffield *et al* teaches that a printhead should be provided that is smaller than the span of the printing path so that it can move along the printing path. There is no teaching or suggestion by Suzuki in view of Duffield *et al* that the printhead is an integrated circuit. Furthermore, there is no teaching or suggestion by Suzuki in view of Duffield *et al* that the printhead integrated circuit is positioned in the outlet to span the printing path.

MPEP 2143 states:

*"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.**"* (emphasis added)

In this instance, the Examiner has not met at least the third basic criteria to establish a *prima facie* case of obviousness.

Based on the above reasons, the Applicant respectfully requests reconsideration and withdrawal of the claim rejections.

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections. The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

Applicant:



Kia Silverbrook

C/o: Silverbrook Research Pty Ltd
393 Darling Street
Balmain NSW 2041, Australia

Email: kia.silverbrook@silverbrookresearch.com

Telephone: +612 9818 6633

Facsimile: +61 2 9555 7762